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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,240	11/26/2003	James V. Howard	P0910D	6031
23735 7590 07/18/2007 DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			EXAMINER STREGE, JOHN B	
			ART UNIT 2624	PAPER NUMBER
			MAIL DATE 07/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/723,240

Applicant(s)

HOWARD ET AL.

Examiner

John B. Strege

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/5/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14, and 19-20, drawn to a system for issuing identification documents to a plurality of individuals, classified in class 382, subclass 115.
 - II. Claims 15-17, drawn to creating a biometric template of an individual for facial recognition processing, classified in class 340, subclass 5.53.
 - III. Claim 18, drawn to searching a database of biometric templates, classified in class 707, subclass 7.
2. Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as creating a template for a search, and subcombination III has separate utility such as using a template for a search. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a

claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

During a telephone conversation with Steven Stewart on 7/09/07 a provisional election was made with traverse to prosecute the invention of group I, claims 1-14, and 19-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-14,19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Slocum et al. USPN 6,430,306 (hereinafter "Slocum").

Regarding claim 1 Slocum discloses a system for issuing identification documents to a plurality of individuals (col. 1 lines 5-10), comprising: a first database, the first database storing a plurality of digitized images, each digitized image comprising a biometric image of an individual seeking an identification document (col. 6 lines 1-6); a first server in operable communication with the first database (col. 6 lines 7-9), the first server programmed to send, at a predetermined time, one or more digitized images

from the first database to a biometric recognition system, the biometric recognition system in operable communication with a second database, the second database containing biometric templates associated with individuals whose images have been previously captured (col. 8 lines 10-38); receive from the biometric recognition system, for each digitized image sent, an indicator, based on the biometric searching of the second database, as to whether the second database contains any images of individuals who may at least partially resemble the digitized image that was sent (col. 9 lines 50-61); and a workstation in operable communication with the first server, the workstation configured to permit a user to review the indicator and to make a determination as to whether the individual is authorized to be issued an identification document or to keep an identification document in the individual's possession (col. 10 lines 3-32).

Regarding claim 2, the digitized image of Slocum is a facial image (col. 1 lines 5-11).

Regarding claim 3, Slocum discloses that the identification document can be a driver's license (col. 5 line 45).

Regarding claims 4-5, Slocum discloses creating eigenvectors (biometric template) and providing the template to a recognition system (col. 8 lines 10-38).

Regarding claim 6, Slocum discloses comprising a list of data associated with individuals whose images at least partially resemble the digitized image that was sent (col. 10 lines 3-32).

Regarding claim 7, Slocum discloses a third database in operable communication with the workstation, the third database storing at least one of images and non-image data associated with each biometric template in the second database, wherein the workstation is configured to be able to retrieve information from the third database upon request and display it to a user (col. 9 lines 37-45).

Regarding claim 8, Slocum discloses wherein the indicator comprises a user interface, the user interface retrieving from the third database the images of at least a portion of the images of individuals that the biometric recognition system has determined may at least partially resemble the digitized image that was sent (col. 10 lines 3-32).

Regarding claim 9, Slocum discloses visually comparing the digitized image that was sent directly to an image of an individual whose data was returned in the indicator by the facial recognition search system (col. 10 lines 3-32).

Regarding claim 10, Slocum discloses a data acquisition element (22 of figure 1).

Claims 11-12 are similarly analyzed to claim 1.

Regarding claim 13, Slocum discloses storing the image and demographic data into an enforcement buffer within the data processor and can have a law enforcement official issue a citation to the applicant.

Regarding claim 14, Slocum discloses receiving an indicator from an investigator and repeating the steps (col. 10 lines 3-54).

Claim 19 is similarly analyzed to claim 1.

Regarding claim 20, Slocum discloses using valid data in its determination (col. 10 lines 3-32).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Strege whose telephone number is (571) 272-7457. The examiner can normally be reached on Monday-Friday between the hours of 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS


BHAVESH M. MEHTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600